

Amendments to the Drawings:

Explain all changes made to the drawings here.

In Figure 5, the reference sign **510** has been added to the drawing, as required by the Examiner.

Attachment: Replacement Sheet(s)
 Annotated Sheet(s) Showing Changes

REMARKS/ARGUMENTS

Claims 1-9, 12, 14-22, and 25 are pending in the present application. By the present response, claims 10-11, 13, 23-24, and 26 are cancelled and claims 1, 5, 7-8, 12, 14, 18, 20-21, and 25 are amended. Support for these amendments is found in Figure 5 and in the specification on page 12, lines 18-26 and on page 14, line 3 through page 16, line 3. Reconsideration of the claims is respectfully requested.

I. Examiner Interview

The Examiner is thanked for the courtesy of an interview, during which the amendments to claim 1 were discussed. Applicants understand that these amendments overcome the cited art, but that another search will be necessary.

II. Drawing Corrections

The drawings have been objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include reference sign 510, mentioned in paragraphs 48, 49, and 70. In response, Figure 5 has been amended to include this reference sign. A red-lined copy of this amendment is also enclosed. No new matter has been added.

III. 35 U.S.C. § 102, Anticipation

The Examiner has rejected claims 10 and 23 under 35 U.S.C. § 102 as being anticipated by **Ball et al.** (U.S.PG Pub US 2002/0126135 A1). Claims 10 and 23 have now been cancelled and their rejection is therefore moot.

IV. 35 U.S.C. § 103, Obviousness

IV.A. Claims 11 and 24 stand rejected under 35 U.S.C. 103(a) as being obvious over **Ball** in view of **Microsoft Outlook**, hereinafter **Outlook**. Claims 11 and 24 have now been cancelled and their rejection is therefore moot.

IV.B. Claims 1-6, 14-19, 25 and 26 stand rejected under 35 U.S.C. 103(a) as being obvious over **Ball** in view of **Microsoft Windows Paint**, hereinafter **Paint**. Claim 26 has now been cancelled and its rejection is moot. Regarding the other claims, the rejection states:

As to claim 1, note the discussion above, Ball teaches a method in a data processing system for managing messages, which comprises placing a marker in a text message wherein the marker is associated with the selected image. Ball does not teach displaying a viewport on a display in association with a chat

window, wherein the viewport defines an area on the display responsive to a user input to select an image, defining the image as graphical data in the area defined by the viewport to form a selected image and placing the marker in the chat window. Microsoft Windows Paint teaches displaying a viewport on a display (Fig 1 reference character 100), wherein the viewport defines an area on the display (Fig 2a reference character 200 "selection tool"), responsive to a user input to select an image, and defining the image as graphical data in the area defined by the viewport to form a selected image (Fig 2b rectangular dotted line).

Figures 3a, 3b, and 4, show the process of placing the selected image by a copy and paste function into a word processing application with similar features as a chat window such as formulating textual messages and functionality of inserting images. It would have been obvious to one skilled in the art at the time of the invention was made to have recognized the similar features of a chat window to any word processing application an correlated the advantages of users communicating directly with one another as discussed by Ball (paragraph 3). The motivation to combine a viewport with a chat window would enhance the quality of text messaging by reducing the time to transfer images by not utilizing attachments to send images, which is discussed by Ball (paragraph 5).

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Claim 1 has been amended to recite that the image seen through the viewport defines the image that will be captured. Claim 1 now states:

1. A method in a data processing system for managing messages, the method comprising the computer-implemented steps:
displaying a viewport on a display, the viewport being adjacent to and in association with a chat window, wherein a region visible through the viewport defines an area on the display to be captured;
responsive to a user input to select an image, defining the image of the region encompassed by the viewport as a selected image; and
placing a marker in a text message in the chat window, wherein the marker is associated with the selected image.

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

No *prima facie* case of obviousness can be made against amended claim 1 using the references relied on because neither the references relied on nor their combination teaches or suggests, "*displaying a viewport on a display, the viewport being adjacent to and in association with a chat window, wherein the region visible through the view port defines an area on the display to be captured,*" as claimed. This step is neither shown nor suggested for at least the following reasons:

- **Paint** is a self-contained program that acts only on those documents that **Paint** has created or which the program is able to open. No evidence is known to the undersigned

agent or has been presented to suggest that the program **Paint** can create images of objects or documents that are “adjacent to” and therefore outside of the program. While the Examiner’s assertion that images from **Paint** can be copied and pasted into other programs is acknowledged, such a capability is not the same as capturing an image visible through a “*viewport ... adjacent to ... a chat window*”, as is recited in claim 1.

- **Ball** discloses an instant messaging program that can include images or “representations of images” (paragraph 0256), but this reference further discloses that the sender sends stored images, such as “one or more images from the sender’s library of digital images” (paragraph 0257, emphasis added). **Ball** does not have the capability to capture an image visible through a “*viewport ... adjacent to ... a chat window*”, as is recited in claim 1.
- Because neither of the references relied on discloses or suggests the feature of “*a viewport ... adjacent to and in association with a chat window, wherein a region visible through the view port defines an area on the display to be captured*”, no combination of these references either discloses or suggests this feature.

In addition to the reasons shown above, no teaching or suggestion exists in the combination of these two references that the steps be “*computer-implemented*”, as is recited in claim 1. The copy and paste example that the Examiner has provided requires user action, not only to define the area to be captured, but also to take part in the actual transfer of the image into another program. Once the user has instructed a first program to capture the desired image, the user must then move to the desired destination program and instruct the destination program to paste the image in a desired location. This sequence does not suggest the computer-implemented steps in which “*responsive to a user input to select an image, defining the image of the region encompassed by the viewport as a selected image; and placing a marker in a text message in the chat window, wherein the marker is associated with the selected image*”, as is recited in claim 1.

Accordingly, the proposed combination when considered as a whole does not teach or suggest all of the features of claim 1. For this reason, the Examiner has failed to state a *prima facie* obviousness rejection of claim 1 and the rejection is overcome. Additionally, claims 14 and 25 are rejected for reasons similar to claim 1, so the rejection of these claims is also overcome. Claims 2-6 are each dependent on claim 1 and claims 15-19 are each dependent on claim 14; therefore the rejections of these claims are overcome for the same reasons. Therefore, the rejection of claims 1-6, 14-19, 25 and 26 under 35 U.S.C. § 103 has been overcome.

IV.C. Claims 12 and 13 stand rejected under 35 U.S.C. 103(a) as being obvious over **Ball** in view of **Paint** and **McKelvie et al.** (U.S. PG Pub US 2003/0217096 A1), hereinafter **McKelvie**. Claim 13 is cancelled and its rejection is therefore moot. Regarding claim 12, the rejection states:

As to claim 12, note the discussion above, **Ball** in view of Microsoft Windows Paint teaches a data processing system for managing messages and displaying a viewport on a display in association with a chat window in which the viewport defines an area on the display, defines the image as graphical data in the area defined by the viewport to form a selected image in response to a user input to select and image and place a marker in a text message in the chat window in which the marker is associated with the selected image. **Ball** and Microsoft Windows Paint does not explicitly teach a bus system, a communications unit connected to the bus system, wherein the memory includes a set of instructions and a processing unit connected to the bus system, wherein the processing unit executes the set of instructions. **McKelvie** teaches a bus system (Fig 14 reference character 147, paragraph 368), a communications unit connected to the bus system (Fig 14 reference character 146, paragraph 369), a memory connected to the bus system, wherein the memory includes a set of instructions (Fig 14 reference characters 142 and 143, paragraph 368), and a processing unit connected to the bus system, wherein the processing unit executes a set of instructions (Fig 14 reference character 141, paragraph 368).

It would have been obvious to one skilled in the art at the time the invention was made to combine a bus system, a communications unit connected to the bus system, wherein the memory includes a set of instructions and a processing unit connected to the bus system, wherein the processing unit executes the set of instructions of **McKelvie** with the data processing system of **Ball** as modified by Microsoft Windows Paint. The motivation to combine is well known in the art and is a general representation of any processing unit that would require implementation of software. In particular the system taught by **McKelvie** embodied around the same art of communications (i.e. chat windows and instant messages) as the application.

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Claim 12 is rejected for reasons similar to claim 1. Additionally, claim 12 provides similar distinctions over **Paint** and **Ball** as claim 1. Specifically, neither **Paint** nor **Ball**, nor their combination discloses or suggests the feature of *“displaying a viewport on a display, the viewport being adjacent to and in association with a chat window, wherein the region visible through the view port defines an area on the display to be captured”*, as previously discussed. Additionally, no teaching or suggestion exists in the combination of these two references that the steps be *“computer-implemented”*. Additionally, **McKelvie** does not make up for the deficiencies of **Paint** and **Ball**. **McKelvie** does not disclose or suggest *“displaying a viewport on a display, the viewport being adjacent to and in association with a chat window, wherein the region visible through the view port defines an area on the display to be captured”*, nor does the rejection suggest otherwise.

Accordingly, the proposed combination when considered as a whole does not teach or suggest all of the features of claim 12. For this reason, the Examiner has failed to state a *prima facie* obviousness rejection of claim 12. Therefore, the rejection of claim 12 under 35 U.S.C. § 103 has been overcome.

IV.D. Claims 9 and 22 stand rejected under 35 U.S.C. 103(a) as obvious over **Ball** in view of **Paint** and **Outlook**. The rejection states:

As to claim 9, not the discussion above, **Ball** as modified by Microsoft Windows **Paint** teaches the method of a data processing system for managing messages as in claim 1. **Ball** and modified by Microsoft Windows **Paint** does not teach wherein messages, markers in the messages, and images are stored in a log allowing for later review of the log with the images being displayed in the proper context with the text. Microsoft **Outlook** teaches wherein messages, markers in the messages, and images are stored in a log allowing for later review of the log with the images being displayed in the proper context with the text. It would have been obvious to one skilled in the art at the time the invention was made to have combined the teachings of **Ball** as modified by Microsoft Windows **Paint** with the logging capabilities of Microsoft **Outlook**. The motivation for combining the method of **Ball** as modified by Microsoft Windows **Paint** with the method of **Outlook** is to keep a record of the messages for future use and to refer back to when needed without the materials needing to be re-sent.

As to claim 22, **Ball** as modified by Microsoft Windows **Paint** teaches the method of a data processing system for managing messages as in claim 14. **Ball** and modified by Microsoft Windows **Paint** does not teach wherein messages, markers in the messages, and images are stored in a log allowing for later review of the log with the images being displayed in the proper context with the text. Microsoft **Outlook** teaches wherein messages, markers in the messages, and images are stored in a log allowing for later review of the log with the images being displayed in the proper context with the text. It would have been obvious to one skilled in the art at the time the invention was made to have combined the teachings of **Ball** as modified by Microsoft Windows **Paint** with the logging capabilities of Microsoft **Outlook**. The motivation for combining the method of **Ball** as modified by Microsoft Windows **Paint** with the method of **Outlook** is to keep a record of the messages for future use and to refer back to when needed without the materials needing to be re-sent.

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Claims 9 is dependent upon claim 1 and claim 22 is dependent upon claim 14. Additionally, claims 9 and 22 provide distinctions over **Paint** and **Ball** similar to those of claim 1. Specifically, neither **Paint** or **Ball** or their combination discloses or suggests the feature of “*displaying a viewport on a display, the viewport being adjacent to and in association with a chat window, wherein the region visible through the view port defines an area on the display to be captured*”, as discussed in reference to claim 1. Additionally, no teaching or suggestion exists in the combination of these two references that the steps be “*computer-implemented*”. Additionally, **Outlook** does not make up for the deficiencies of **Paint** and **Ball**. **Outlook** does not disclose or

suggest “*displaying a viewport on a display, the viewport being adjacent to and in association with a chat window, wherein the region visible through the view port defines an area on the display to be captured,*” nor does the rejection suggest otherwise. Accordingly, the proposed combination when considered as a whole does not teach or suggest all of the features of claims 9 and 22. For this reason, the Examiner has failed to state a *prima facie* obviousness rejection for claims 9 and 22. Therefore, the rejection of claims 9 and 22 under 35 U.S.C. § 103 has been overcome.

V. **Objection to Claims**

The Examiner has stated that claims 7, 8, 20, and 21 were objected to as being dependent upon a rejected base claim. In response, the claims have been rewritten to overcome this objection.

VI. **Conclusion**

The subject application is patentable over the cited references and should now be in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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